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In re Application of: :
Enok Rjotta :
Serial No.: 10/530,488 : PETITION DECISION
Filed: April 6, 2005 :
Attorney Docket No.: 3657-1025 :

This is in response to the petition under 37 CFR § 1.181, filed March 17, 2009, requesting that the finality of the Office action of September 17, 2008 be withdrawn.

It is noted that applicant filed this petition under 37 CFR § 1.181 on March 17, 2009 requesting relief from the finality of the Office action mailed September 17, 2008. This petition was not filed within two months from the mailing of the final Office action and is thus untimely. Nevertheless, a decision on this petition is rendered herein.

BACKGROUND

The examiner mailed a non-final Office action on September 11, 2007 setting a three month statutory limit for reply. At the time of this non-final Office action, claims 13-27 were pending and claims 13-27 were examined on their merits. The examiner rejected claims 13-27 under 35 USC 112, second paragraph, for being indefinite. Specifically, the examiner indicated the claims were incomprehensible.

On January 11, 2008, applicant submitted a response including arguments and cancelled claims 13-27 and added new claims 28-61.

On May 8, 2008, the examiner set forth a restriction requirement wherein the claims 28-61 were restricted into three groups. The examiner also required applicant to elect a single disclosed species for prosecution on the merits.

On June 9, 2008, applicant elected Group I with traverse and species 1, drugs, with traverse.

On September 17, 2008, the examiner mailed a final Office action setting a three month statutory limit for reply. At the time of this final Office action, claims 28-61 were pending in the application. Claims 42, 43, 45 and 47-60 were withdrawn from examination on their merits, and claims 28-41, 44, 46 and 61 were examined on their merits. Specifically, claims 28-41, 44, 46 and 61 were rejected under 35 USC 112, second paragraph and claims 28-41, 44 and 46 were rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. Claims 28-32, 34-36, 38-41, 44, 46 and 61 were rejected under 35 USC 102(b) as being anticipated by Prechel et al. as evidenced by Car et al. Claim 33 was rejected under 35 USC 103(a) as being unpatentable over Prechel et al. in view of De Asua et al. and in view of Kamei H. Claim 37 was rejected under 35 USC 103(a) as being unpatentable over Prechel et al. in view of Tami et al.

In response to the final Office action, applicant filed an amendment after final on December 17, 2008 with remarks and amendments to the claims.

On March 12, 2009, the examiner mailed an Advisory Action which indicated the proposed amendment would not be entered because it raised the issue of new matter.

In response thereto, applicant filed this petition on March 17, 2009, requesting that the finality of the Office action of September 17, 2008 be withdrawn.

DISCUSSION

The petition and the file history have been carefully considered.

In the petition filed on March 17, 2009, applicant requests reconsideration of the finality rendered in the Office action mailed by the examiner on September 17, 2008 because it is considered that the final rejection was premature and improper.

Applicant argues that there was no substantive prosecution on the merits until the final Office action and that, specifically, there was no prior art applied to reject the claims or issues raised under 35 USC 112, first paragraph, until the issuance of the final Office action of September 17, 2008 which was not proper.

Applicant's argument is not persuasive because as the examiner pointed out in the non-final Office action of September 11, 2007, that the claims were incomprehensible as set forth and, as a result, the metes and bounds of the claims could not be determined. The examiner did, however, set forth numerous rejections under 35 USC 112, second paragraph. In any event, prior art rejections were properly not made by the examiner in the non-final Office action of September 11, 2007 because the metes and bounds of the claims could not be determined. Applicant's subsequent amendment to the claims on January 11, 2008, wherein all of the original claims were cancelled and new claims were introduced thus necessitated the examiner's rejection of all the new claims.

Applicant should note that MPEP § 706.07 provides:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

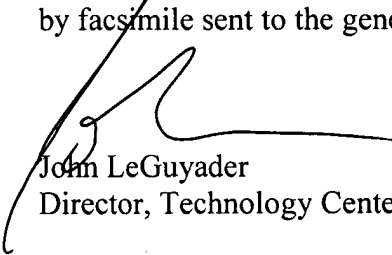
Thus, in the instant case, it is evident that applicant's amendment cancelling original claims 1-27 and introducing new claims 28-61 necessitated a new ground of rejection. Consequently, the final Office action of September 17, 2008 is not considered improper and the finality of said Office action will not be withdrawn.

DECISION

The petition is **DENIED**.

Any new or renewed petition must be filed within TWO MONTHS of the mail date of this decision.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.



John LeGuyader
Director, Technology Center 1600